IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:		Confirmation No.:	**1598**
	Jerding *et al.*	Group Art Unit:	**2424**
Serial No.:	**09/590,904**	Examiner:	**Shang, Annan Q**
Filed:	**June 9, 2000**	Docket No.:	**A-6585**

For: **PROGRAM INFORMATION SEARCHING SYSTEM FOR INTERACTIVE PROGRAM GUIDE**

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
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Sir:

This is a Reply Brief in response to the Examiner's Answer dated November 18, 2008.

I. STATUS OF THE CLAIMS

Claims 2, 3, 5-30, 32-37, 39-54, and 59-64 remain pending in the present application. Appellants acknowledge the withdrawal of the rejection of claims 2, 3, 5-30, 32-37, and 39-64 under 35 U.S.C. § 112, first paragraph. The Examiner's Answer maintains the rejections of claims 2, 3, 5-30, 32-37, 39-54, and 59-64 under 35 U.S.C. § 103(a) and generally repeats the arguments advanced during prosecution of this application along with providing comments (in the Response to Argument Section, pages 10-17 of the Examiner's Answer) to the Appeal Brief, filed on August 15, 2008. With regard to the substantive remarks of the Examiner's Answer, Appellants disagree. Although Appellants will address some issues raised in the Examiner's Answer, Appellants continue to repeat, re-allege, and incorporate by reference the positions and arguments set forth in the Appeal Brief.

II. ARGUMENTS

Appellants address some of the rebuttal comments beginning on page 11 of the Examiner's Answer below. The omission of discussion pertaining to some issues raised in the Examiner's Answer should not be interpreted as an admission of the assertions made in the Examiner's Answer.

Independent Claim 63 and Dependent Claims 2-3, 5-30, and 59-60

The Examiner's Answer provides the following rebuttal comments, beginning on page 12, and set forth below in relevant part:

> Rothmuller further discloses that MP-15 is configured with the UI module to associate the program information with the initial IPG arrangement and further present an initial IPG arrangement on a display device (see fig.2), the initial IPG arrangement including a channel area (interactive cells DTV 200, CNN 202,....A&E 256+), a first program display area (cells DIRECTV [*sic*]....to 55 DAYS AT PEKING, which displays program(s) associated with each channel) adjacent the channel area, and a browse-by-icon or browse area (interactive cells of varying length area, MAIN MENU, CATEGORIES, TYPES,....CLASSES), col.4, lines 29-53). When

> a user interacts with the various cells or the IPG using a remote control, cursor by highlighting a program of interest or keyboard by entering of alphanumeric characters (col.4, line 54-col.5, line 3 and lines 28-39) to input selection in the browse area cells or EPG cells (channels and programs), the MP-15/Display engine presents a first IPG arrangement on the display device responsive to the first user input, the first IPG (EPG-1) arrangement comprising a browse-by area that displaces the channel area, the browse-by area having a search option (favorite list, col. 5, lines 4-48)...

Specifically, *Rothmuller* teaches that:

> FIG. 2 illustrates an exemplary program guide produced by apparatus 10. As shown in FIG. 2, each screen of the program guide comprises approximately seven program sources and the corresponding programs. The program source and the programs being shown thereon are displayed on a single line comprising multiple cells of varying length. The first cell in each line indicates the program source and the channel number assigned to the source. In order to view additional program information, the viewer simply presses a designated key, such as a page down key (i.e., scroll down key), and the foregoing process is repeated for the new program data to be displayed.

As such, the Examiner's Answer appears to allege that the program guide of FIG. 2 corresponds to an initial IPG arrangement, where the seven program sources correspond to "a channel area", the programs being shown correspond to "a first program display area adjacent the channel area", and the items of FIG. 2 labeled MAIN MENU, CATEGORIES, TYPES, LISTS, GUIDES, and CLASSES correspond to "a browse-by icon".

Even assuming, *arguendo*, that the items of FIG. 2 labeled MAIN MENU, CATEGORIES, TYPES, LISTS, GUIDES, and CLASSES are icons, *Rothmuller* does not disclose or suggest "present a first IPG arrangement on the display device responsive to [selection of one of the alleged icons], the first IPG arrangement comprising a browse-by area that displaces the channel area, the browse-by area having a search option" as recited in claim 63. This appears to be supported by the admission on page 17 of the Examiner's Answer, which states that "Rothmuller is silent as to the claimed browse-by icon..." Thus, *Rothmuller* does not teach or suggest "a browse-by icon" as recited in claim 63.

In addition, *Rothmuller* does not even mention selecting the items of FIG. 2 labeled MAIN MENU, CATEGORIES, TYPES, LISTS, GUIDES, and CLASSES. Nor are programs associated with each channel the same as the alleged icons. Accordingly, Appellants respectfully submit that "entering the title of the program is via an infra-red "IR" remote 40 control device... so as to highlight the program of interest" (*Rothmuller* at col. 4, line 61 to col. 5, line 1) is not the same as "selection of the browse-by icon". Further, Appellants submit that "the title of the desired program can be entered via a keyboard ... and/or an IR remote which provides for entry of alphanumeric characters" (*Rothmuller* at col. 5, lines 28-30) is not the same as "selection of the browse-by icon". Thus, *Rothmuller* does not teach or suggest "receive a first user input corresponding to selection of the browse-by icon" as recited in claim 63.

Furthermore, the Examiner's Answer appears to allege that a favorite list corresponds to "a first IPG arrangement". However, *Rothmuller* does not disclose or suggest that a favorite list is presented in response to selecting one of the items of FIG. 2 labeled MAIN MENU, CATEGORIES, TYPES, LISTS, GUIDES, and CLASSES. Even assuming, *arguendo*, that the favorite list is presented, *Rothmuller* does not disclose or suggest the favorite list includes "a browse-by area that displaces the channel area, the browse-by area having a search option" as recited in claim 63. Rather, *Rothmuller* teaches that:

> ...the present invention also relates to a method for automatically generating a favorite program list. The favorite program list identifies by title, the programs most frequently watched by the viewer. The favorite program list can also include information, such as, the time and channel of the next occurrence of each program contained in the favorite program list.

(Col. 5, lines 51-58). Alternatively, *Rothmuller* teaches the following:

> Depression of the SEARCH key commands the microprocessor 15 to determine if the program currently highlighted by the viewer is contained anywhere else in the program guide...
>
> ...if additional matches are found, the microprocessor 15 records the channel of broadcast and time of broadcast of each occurrence of the program ... and displays the time and channel information ... for each

> occurrence of a desired program... on the display screen via the same components utilized to display the program guide.

(Col. 5, lines 51-58), *Rothmuller* does not disclose or suggest the displayed information includes "a browse-by area that displaces the channel area, the browse-by area having a search option". Thus, *Rothmuller* does not teach or suggest "present a first IPG arrangement on the display device responsive to the first user input, the first IPG arrangement comprising a browse-by area that displaces the channel area, the browse-by area having a search option" as recited in claim 63. This fact appears to be supported by the Examiner's Answer, which admits on page 14 that "Rothmuller ... [is] silent as to ... a user-selectable search option, having browse-by area having a search option..."

The addition of *Legall* does not overcome these deficiencies. The Examiner's Answer alleges on page 14 that:

> However, in the same field of endeavor, **Legall** ... discloses browse-by-con [*sic*] (figs.2-3C, where a user can interact to various icon to display information associated with each icon) a user-selectable search option having browse area and various guide arrangements and additional search options; Power Search area which is also a channel area for selecting channels to be searched, while retaining in a display, the program display area (figs.2 and 3B and col. 2, line 57-col. 5, line 1+), note that Legall clearly illustrates a display interface of multiple windows, one that displays the current tune channel and second window which includes a channel search area and also a power search area where a user selectable search option are displayed, and further discloses that once the user selects to proceed with the search, e.g., using "go" button 348...

(Emphasis in original). Appellants respectfully disagree. Specifically, *Legall* teaches that:

> ...referring to FIG. 2, the display may include a program currently being broadcast in area 205, HTML frame 210, which may display a list of web sites or a particular web site 215, and/or electronic program guide of broadcast information 220, and a tool area, which enables the user to manipulate the information and resources used and the information displayed including the power search tool that is described below. ... Window 220 adapts the EPG window to display the result of broadcast data query.
>
> FIG. 3b illustrates one example of a display which includes the search tool of the present invention. The window 375 includes a topic area 340 in which the user can define the topic which is the subject of the filter. ...

> Once the user selects to proceed with the search, e.g., using "go" button 348 the window is shifted to display the power search result window (e.g., window 210, FIG. 2).

(Col. 2, lines 40-58 and col. 3, lines 28-46). Even assuming, *arguendo*, that the "go" button 348 is an icon, *Legall* does not disclose or suggest that the "go" button 348 is "a browse-by icon". Rather, *Legall* teaches "using "go" button 348 ... to display the power search result window (e.g., window 210, FIG. 2)" (col. 3, lines 44-46). Appellants respectfully submit that the power search result window 210 is not the same as "a browse-by area that displaces the channel area, the browse-by area having a search option" as recited in claim 63.

While *Legall* appears to teach that power search window 375 (FIG. 3B) "is shifted to display the power search result window (e.g., window 210, FIG. 2)" (col. 3, lines 44-46), *Legall* does not disclose or suggest that the power search window is a "channel area". Indeed, there is not a single channel listed in FIG. 3B in the area identified by 375. Further, the area identified with the EPG in the upper right hand corner of the display is clearly distinguishable from the power search area 375 residing in the middle of the display. Thus, *Legall* does not teach or suggest "present a first IPG arrangement on the display device responsive to the first user input, the first IPG arrangement comprising a browse-by area that displaces the channel area, the browse-by area having a search option" as recited in claim 63.

As is well established in the law, the claims must be considered <u>as a whole</u>. *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987) (In determining obviousness, "the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed"). When Appellants' claim is considered as a whole, it becomes clear that *Legall* does not teach what the Examiner's Answer alleges. Accordingly, Appellants respectfully submit that *Legall* does not disclose or suggest either "a browse-by icon" or "receiv[ing] a first user input corresponding to selection of the browse-by icon" as recited in claim 63.

Additionally, the Examiner's Answer alleges on page 15 that:

> ...the combination of Rothmuller in view of Legall is deemed proper, meets all the claims limitations and should be sustained. Clearly all of the elements were known in the art and could have been combined by well known programming techniques. This would not have changed any functions...

Appellants respectfully disagree. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

As discussed above, while *Legall* appears to teach that power search window 375 (FIG. 3B) "is shifted to display the power search result window (e.g., window 210, FIG. 2)" (col. 3, lines 44-46), neither *Rothmuller* nor *Legall* disclose or suggest "a browse-by area that displaces the channel area, the browse-by area having a search option" as recited in claim 63. In contrast, *Legall* teaches that "Once the user selects to proceed with the search, e.g., using "go" button 348 the ... EPG is also updated to reflect those programs that meet the filter criteria (see e.g., window 220, FIG. 2)" (col. 3, lines 43-46). Similarly, *Rothmuller* teaches that "if additional matches are found, the microprocessor 15 records the channel of broadcast and time of broadcast of each occurrence of the program ... and displays the time and channel information ... for each occurrence of a desired program... on the display screen via the same components utilized to display the program guide" (col. 5, lines 51-58).

Appellants respectfully submit that, *arguendo*, if the channel area is displaced as alleged, then the channel information could not be updated as described in *Rothmuller* and *Legall*. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. Therefore, the references teach away from their combination. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As is well established in the law, "[t]here is no suggestion to combine ... if a reference teaches away from its combination with

another source ... A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant ..." *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999).

Rather, it appears that the only suggestion or motivation comes from Appellants' own disclosure. As is well established in the law, such hindsight to the Appellants' own disclosure is *per se* improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention).

Accordingly, for at least these reasons, Appellants respectfully submit that a *prima facie* case of obviousness is not established for independent claim 63, and hence respectfully request that the rejection be overturned.

Because independent claim 63 is allowable over *Rothmuller* and *Legall*, dependent claims 2, 3, 5-30, 59, and 60 are allowable as a matter of law for at least the reason that the dependent claims 2, 3, 5-30, 59, and 60 contain all elements of their respective base claim. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, Appellants respectfully request that the rejection be overturned for at least the same reasons the rejection should be overturned for the base independent claim.

Independent Claim 64 and Dependent Claims 32-37, 39-54, and 61-62

While claim 64 is not coextensive with claim 63, claim 64 embodies limitations that are similar to the defining features of claim 63. For purposes of this appeal, these claims do define over the cited *Rothmuller* and *Legall* references for the same reasons as claim 63 insofar as the claim defines substantive features that are similar to the defining features of claim 64, and the Examiner's Answer relies on the same teachings of *Rothmuller* and *Legall* as applied to the

corresponding elements of claim 63. Specifically, claim 64 defines (among other distinguishing features) "a browse-by icon", "receiving a first user input corresponding to selection of the browse-by icon", and "presenting a first IPG arrangement on the display device responsive to the first user input, the first IPG arrangement comprising a browse-by area that displaces the channel area, the browse-by area having a search option". With regard to these features, the Examiner's Answer has applied the same portions of *Rothmuller* and *Legall* as allegedly teaching these features.

Accordingly, for at least the reasons discussed above, Appellants respectfully submit that a *prima facie* case of obviousness is not established for independent claim 64, and hence respectfully request that the rejection be overturned.

Because independent claim 64 is allowable over *Rothmuller* and *Legall*, dependent claims 32-37, 39-54, 61, and 62 are allowable as a matter of law, and hence for the same reasons as expressed above for claim 64, the rejection should be overturned. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, Appellants respectfully request that the rejection be overturned for at least the same reasons the rejection should be overturned for the base independent claim.

Dependent Claims 9-14 and 39-41

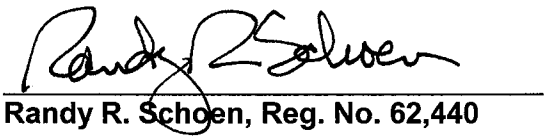
As explained above, Appellants respectfully submit that *Rothmuller* in view of *Legall* fails to disclose, teach, or suggest all of the features of independent claims 63 and 64. The addition of *Boyer* fails to remedy these deficiencies. Accordingly, Appellants respectfully submit that claims 9-14 and 39-41, which incorporate the respective base claim features, are allowable as a matter of law, and hence the rejection of claims 9-14 and 39-41 should be overturned.

III. CONCLUSION

Based upon the foregoing discussion, the Appellants respectfully request that the Examiner's final rejection of claims 2, 3, 5-30, 32-37, 39-54, and 59-64 be overruled and withdrawn by the Board, and that the application be allowed to issue as a patent with all pending claims.

No additional fee is believed to be due. However, any additional fee that may be due or required is authorized to be charged to deposit account no. 19-0761.

Respectfully submitted,

By: 

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